REMARKS

Applicant has provided an amended claim set in order to advance the application through grant. Upon review of the outstanding Action and in view of the comments made herein, Applicant would like to briefly set forth the basic concept of the subject invention.

The claimed invention is directed to a system and method for the redemption of gift vouchers and other stored valued instruments (for example, the system of the claimed invention may also be used to process checks. The methodology and the manner in which such instruments are handled is fundamentally different from the way in which reward scheme, discount coupon, and other promotional coupons are handled.

In the case of the claimed invention, the voucher must be purchased by a purchaser (who will usually provide the voucher for a designated beneficiary). The voucher has an attached value which can be cashed-in by the voucher holder and is therefore a stored value instrument. As the voucher has a stored value, security must be provided by the provision of a separate token to the beneficiary. A stored value instrument such as a gift voucher requires debiting of an account. This is not something which is required, for example, by a coupon which is merely "*money off*" the product to be purchased. A coupon does not have any stored value. If the coupon is lost, for example, no account is affected. A stored valued instrument is analogous to "*currency*" whereas a coupon is not. Furthermore, a coupon cannot be debited for part of its value (as it has no inherent value), whereas a stored value instrument can.

Coupons and stored value instruments in view of these comments are therefore very different items. Security is particularly important for stored value instruments because they have

an inherent value. The claimed invention has been designed particularly to provide security for stored value instruments and is not concerned with the distribution of coupons.

Another important point to note is that the claimed invention is directed towards providing a number of alternate routes by which a stored value instrument may be redeemed. All prior art solutions directed to the issuance and redemption of stored value instruments concentrate either on the off-line environment or the on-line environment.

That is, traditional paper based gift vouchers have been known for some time. However, the use of such vouchers is inherently limited, since there is no easy way for the vouchers to be tracked across multiple vendors. That is, if a voucher is purchased at one vendor, then it cannot be used at another vendor, as the other vendor has no means of verifying the authenticity of such a voucher. Similarly, on-line voucher systems are also inherently limited to the website or on-line vendor to which they relate, or utilize particularly complex methodologies for verification, which cannot be translated into the off-line world. In other words, the prior art does not teach or disclose a voucher system which is suitable for use in both on-line and off-line environments (*i.e.*, redeemable via a plurality of pathways).

Each of the independent claims as provided herein have been amended to more clearly define these two aspects of the invention. hi addition, Claim 5 has been cancelled, as the subject matter of Claim 5 is now included in Claim 1.

The claimed invention is concerned with a non-complex yet secure way in which to deliver and redeem stored value instruments. It achieves this result, in part, by providing a central computer system which generates a token. The token is easily communicable via any

form of communication, whether it be electronic mail, over the telephone or even printed on a piece of paper. That is, the token may be transmitted via any one of a plurality of pathways.

The *Fortenberry* reference on the other hand, relies on the transfer of machine readable computer files to deliver a coupon to an end user. As the coupon is a machine readable file of substantive size, it cannot be transferred by voice over the telephone, nor can it be transferred via a piece of paper. In other words, *Fortenberry* describes a system which is only suitable for on-line transactions. Furthermore, there is no teaching, either explicit or implicit, that the system of *Fortenberry* could be modified or changed in any way to allow the system of *Fortenberry* to be used in an off-line environment. Indeed, *Fortenberry* is very much directed to the electronic distribution and redemption on the World Wide Web, and there is nothing in the specification whatsoever which would teach the reader to provide a coupon which may be redeemed through both on-line and off-line channels.

With these arguments in mind, is not clear how *Scroggie* could be combined with *Fortenberry* to arrive at the invention. There is no suggestion whatsoever in either reference encouraging the combination as set forth in the Action. *Scroggie* is directed to the issuance of coupons, such as a "*buy one get one free*" type arrangement where consumers are effectively provided with a discount when they purchase a product. This is completely different from a gift voucher. A coupon, when used in the context of *Scroggie*, is not a stored value instrument. That is, the coupon is issued to any number of individuals, and the store/vendor is not concerned about the coupons getting into the "*wrong hands*". In other words, the coupons have no value per se other than as an incentivising device which is used to attract consumers to a vendor. A voucher such as the one defined by the claimed invention, on the other hand, has a stored value, in the

same manner as a check or a credit card.. Moreover, there is no disclosure, teaching or incentive whatsoever in *Scroggie*, either implicit or explicit, of providing a voucher which may be redeemed via any one of a plurality of pathways.

The *Manasse* patent application relies on a complex system of electronic scrips which must be generated, split into halves, each half being associated with a buyer and a seller respectively. The buyer must then transmits their scrip half to the seller, and the seller must have the facilities to decode the buyer's scrip and match the buyer's scrip to their scrip. Compared to Applicant's claimed invention, this system is overly complex and is only workable if the scrips are transmitted via a computer network. Utilizing the invention of the *Manasse* disclosure, it would not be practical for a buyer to walk into a store and hand over a scrip, as the scrip is a complex string of information which cannot be easily printed onto a sheet of paper, nor easily entered into a terminal. Therefore, even when *Manasse* is combined with *Fortenberry*, there is no teaching of providing a voucher system which allows the vouchers to be redeemed by any one of a plurality of pathways.

Lastly, the relevance of *Jacoves*, is in question in view of the amended claims and aforementioned arguments as this reference is not directed to the redemption of gift vouchers or other stored value instruments, but rather to a method of reconciliation for a coupon system. *Jacoves* describes a system for processing information through a clearing house for a rewards program. The invention appears to involve sending information received by vendors which is subsequently sent to a clearing house for processing. This does not appear to be relevant in any way to the presently claimed invention, as the claimed invention implicitly provides for "*real time*" feature processing of vouchers as claimed by Applicant.

This is necessary because, as stated earlier, gift vouchers are stored value instruments, and the validity of a gift voucher must be ascertained before a purchase (either on-line or off-line) is finalized. It does not appear that *Jacoves* contemplates a real time redemption methodology and/or system. Even when *Fortenberry* is combined with *Jacoves*, there is no disclosure whatsoever of a system for the issuance and redemption of stored value instruments which may be redeemed in real-time via any one of a plurality of pathways.

Therefore, there is no teaching, even when any of the cited documents are combined, of:

(a) a system which allows for the issuance and redemption of stored value instruments; and

(b) providing a stored value instrument which may be redeemed in an on-line or an off-line environment (i.e. via any one of a plurality of pathways).

Moreover, it is emphasized that there is no motivation, either implicit or explicit to combine any of the cited references any other reference if there is no indication in the first reference that such combination with a second reference would be desirable.

For example, in the case of *In re Jones*, 958 Fed. 2d, p. 347, 21 USPQ 2d, pp. 1941, 1943 (Fed. Cir 1992), it was stated as follows:

> "*Before the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art*".

Moreover, in the case of Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d p. 1044, and 5 USPQ 2d, p. 1434 (Fed. Cir 1988), it was stated:

> "*When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest desirability, and thus, the obviousness of making the combination. It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention*".

As stated earlier, there is no teaching in *Fortenberry* that the invention of *Fortenberry* could, would or should be combined with any one of *Scroggie*, *Manasse* or *Jacoves*. Moreover, even when these documents are combined, there is no teaching of all of the features of any one of the independent claims.

For all of the reasons given in the rather extensive argumentation provided above, it is claimed that not one reference alone discloses what Applicant has claimed as his invention. Furthermore, the combination of reference as suggested in the outstanding Action, even if permissible, simply does not render the claimed invention obvious. One however, does not get to the point of combining references noting that there is no teaching or motivation whatsoever providing one of ordinary skill in the art to combine any of the cited references much less to pick and choose elements from the reference to arrive at about Applicant has now claimed.

Favorable reconsideration is respectfully requested.

Respectfully Submitted,

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